

REMARKS

The Office Action of October 18, 2005, has been carefully considered. Claims 1, 4-19, 21-26 and 28-34 are pending in the present Application. Claims 1, 11, 19, 26 and 30 are independent claims. Reconsideration and allowance of the Application are respectfully requested.

Claim Rejections Under 35 USC §102

Claims 1, 4-19, 21-26 and 28-34 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,412,428 to Tahara (hereinafter referred to as the Tahara reference). This rejection is respectfully traversed.

In overview, in order for prior art to anticipate a claim under 35 U.S.C. §102 every element of the claimed invention must be identically disclosed either expressly or under principles of inherency in a single reference. Further, the exclusion of a claimed element from a prior art reference, no matter how insubstantial, is enough to negate anticipation by that reference. The test of whether anticipation exists in a particular case is a question of fact, and is applied element-by-element to a single prior art reference. Only if the prior art literally reads on every element of the rejected claim will the claimed invention be anticipated under this test.

With this in mind, the Applicant analyzes the §102 rejection of the claims in the present application. Independent Claim 1 includes the subject matter: “wherein the enhanced information stream is selectively encoded using spatial information obtained from processing of the base information stream or using a previous reference obtained during processing of the enhanced information stream.” Independent Claims 11, 19, and 30 include similar subject matter as well.

1 Independent Claim 26 includes the subject matter: “wherein the enhanced decoder
2 selectively decodes the enhanced information stream using spatial information
3 obtained from processing of the base information stream or using a previous
4 reference obtained during processing of the enhanced information stream.”

5 The present Application describes a process of spatially predicting a P-
6 frame (enhanced information) using a reference from a base stream that is stored
7 in a frame buffer 1132. Also, the present Application describes a process of
8 predicting a P-frame from a previous reference generated from the enhanced
9 stream stored in a frame buffer 1152. A switch 1158 is capable of selectively
10 choosing one of these processes. The Office is directed to page 25 of the present
11 Application for further information related to the foregoing description.
12 Selectively being able to choose between the two processes provides greater
13 efficiency in prediction coding and results in a performance boost in comparison
14 to traditional encoding mechanisms.

15 On page 3 of the current Office Action, the Office asserts column 8, lines
16 54-64 and column 23, lines 23-35 teach the indicated subject matter of the
17 independent claims. Applicant disputes the Office’s assertions for the following
18 reasons.

19 The Office asserts Tahara teaches an enhanced information stream that is
20 selectively encoded using spatial information obtained from processing of a base
21 information stream, or using a previous reference obtained during processing of
22 the enhanced information stream. To substantiate this assertion, the Office
23 maintains that a data stream of a circuit 101 is selectively encoded by way of a
24 select circuit 176. According to the Office, the select circuit 176 selects a
25 predictive error from a data stream of a circuit 100, or a predictive error from “a

1 previous reference of 101.” Regarding the quoted text, the Applicant is not
2 entirely sure what the Office is trying to convey here. The Applicant assumes the
3 Office is asserting that the select circuit 176 is capable of selecting a predictive
4 error that is generated by a circuit 101. Nonetheless, the Office is requested to
5 clarify the quoted text if an additional Office Action is necessary following this
6 Response. The preceding discussion is a summary of the Office’s assertions found
7 on page 3, second full paragraph, of the current Office Action.

8 The Applicant will now describe how the instant claimed invention differs
9 from the Tahara encoding and decoding methods. The circuit 101 is for
10 processing color difference signals with intermediate definition, where the circuit
11 100 is for processing color difference signals with the lowest definition and the
12 luminance signals. (See column 22, lines 48-53.) The color difference signals and
13 luminance signals are described in the patent at *column 8, lines 5-18*. According
14 to the Tahara description at *column 23, lines 23-35*, the select circuit 176 chooses
15 between predictive error signals produced from an up sampling circuit 111 and
16 predictive error signals produced from a motion compensating circuit 175. The
17 circuit 101 includes the up sampling circuit 111 and the compensating circuit 175.
18 (See Fig. 19).

19 The up sampling circuit 111 and the motion compensation circuit 175
20 produce the mentioned predictive error signals from the color difference signals
21 that have intermediate definition. This is described in the Tahara patent at *column*
22 *23, lines 1-5*. The color difference signals with the lowest definition and the
23 luminance signals are not used to produce the predictive error signals discussed in
24 the foregoing. Tahara confirms this fact by stating that the operation of the circuit
25 100 is not discussed in conjunction with the circuit 101. (See column 22, lines 63-

1 65.) Recall, the circuit 100 processes the color difference signals with the lowest
2 definition and the luminance signals. (See column 22, lines 51-53.) The Office
3 asserts the signals processed by the circuit 100 are analogous with the base
4 information stream referenced in the claims.

5 The above shows that the Office's reasoning for finding claims 1, 11, 19,
6 26 and 30 unpatentable lacks merit. In particular, Tahara cannot teach the
7 recitation "the enhanced information stream is selectively encoded using spatial
8 information obtained from the processing the base information stream" (claims 1,
9 11, 19, and 30), or the recitation "the enhanced decoder selectively decodes the
10 enhanced information stream using spatial information obtained from processing
11 of the base information stream" (claim 26), as predictive error signals produced
12 from an up sampling circuit 111 and predictive error signals produced from a
13 motion compensating circuit 175 are not produced by processing signals from the
14 circuit 100; only signals from the circuit 101 are used to produce the predictive
15 error signals generated by the circuits 111 and 175.

16 Regarding the claim recitation that teaches encoding the enhanced
17 information stream "using a previous reference obtained during processing of the
18 enhanced information stream" (claims 1, 11, 19, and 30), and the recitation that
19 teaches an enhanced decoder that selectively decodes "using a previous reference
20 obtained during processing of the enhanced information stream" (claim 26),
21 Applicant respectfully submits that the Tahara is deficient in connection with these
22 limitations as well. Specifically, Tahara describes that the select circuit 176
23 compares predictive error signals output from the up sampling circuit 111 to
24 predictive error signals output from the motion compensation circuit 175. (See
25 column 23, lines 24-28.) The smaller predictive error signals are chosen based on

1 this comparison. (See column 23, lines 28-29.) The chosen smaller predictive
2 error signals are used for encoding and decoding the color difference signals. This
3 teaching cannot be construed as teaching encoding/decoding the enhanced
4 information stream “using a previous reference obtained during processing of the
5 enhanced information stream.”

6 Each of the remaining rejected dependent, depends from either independent
7 Claim 1, 11, 19, 26, or 30 and includes other limitations that are not taught or
8 suggested by the Tahara reference. Therefore, for at least some of the above
9 reasons, Applicant respectfully submits that the §102 rejection of claims 1, 4-19,
10 21-26 and 28-34 is improper, and respectfully requests reconsideration and
11 withdrawal of this rejection.

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13 *Claim Rejections Under 35 USC §103*

14 Claim 29 was rejected under 35 U.S.C. §103(a) as being unpatentable over
15 the Tahara reference in view of Official Notice. For at least some of the reasons
16 that follow, Applicant respectfully disagrees that the subject matter of claim 29 is
17 obvious over the Tahara reference in view of Official Notice.

18 In overview, as stated in MPEP § 2143, to establish a prima facie case of
19 obviousness, three basic criteria must be met. First, there must be some
20 suggestion or motivation, either in the references themselves or in the knowledge
21 generally available to one of ordinary skill in the art, to modify the reference or to
22 combine reference teachings. Second, there must be a reasonable expectation of
23 success. Finally, the prior art reference (or references when combined) must teach
24 or suggest all the claim limitations. The teaching or suggestion to make the
25 claimed combination and the reasonable expectation of success must both be

1 found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20
2 USPQ2d 1438 (Fed. Cir. 1991).

3 Further, as stated in MPEP § 2143.01, obviousness can only be established
4 by combining or modifying the teachings of the prior art to produce the claimed
5 invention where there is some teaching, suggestion, or motivation to do so found
6 either in the references themselves or in the knowledge generally available to one
7 of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.
8 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere
9 fact that references can be combined or modified does not render the resultant
10 combination obvious unless the prior art also suggests the desirability of the
11 combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

12 Therefore, "all words in a claim must be considered in judging the
13 patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 165
14 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35
15 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837
16 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

17 Without repeating the arguments discussed above, the Applicant maintains
18 that the Tahara reference does not teach or suggest a decoder that "selectively
19 decodes the enhanced information stream using spatial information obtained from
20 processing of the base information stream or using a previous reference obtained
21 during processing of the enhanced information stream" as recited in claim 26.
22 Claim 29 is dependent on claim 26 and is at least allowable as a result of this
23 dependency.
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1 Therefore, the Applicant respectfully submits that the §103 rejection of
2 claim 29 is improper, and respectfully requests reconsideration and withdrawal of
3 this rejection.
4

5 **Conclusion**

6 Applicant has considered the other references cited by the Examiner in the
7 Office Action. None of these references appear to affect the patentability of
8 Applicant's claims. By the foregoing remarks, Applicant believes that pending
9 claims 1, 4-19, 21-26, and 28-34 are allowable and the application is in condition
10 for allowance. Therefore, a Notice of Allowance is respectfully requested.
11 Should the Examiner have any further issues regarding this application, the
12 Examiner is requested to contact the undersigned attorney for the Applicant at the
13 telephone number provided below.

14 Respectfully Submitted,

15 Date: January 6, 2006

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